

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHUIYUAN LUO and ALAN L. BILLINGS

Appeal No. 2006-1701
Application No. 10/334,513

ON BRIEF

Before KIMLIN, GARRIS and FRANKLIN, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-5.

Claim 1 is illustrative:

1. An industrial fabric for use in papermaking and papermaking related processes comprising a plurality of uncoated functional monofilaments having a grooved-shaped cross-section and having reduced air permeability compared with a fabric formed of monofilaments having a circular cross-section.

The examiner relies upon the reference in the rejection of the appealed claims:

Dugan et al. (Dugan)

6,093,491

Jul. 25, 2000

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Appellants' claimed invention is directed to an industrial fabric that is used for papermaking and papermaking related processes. The fabric comprises a plurality of uncoated functional monofilaments having a grooved-shaped cross-section. The fabric has reduced air permeability compared with a fabric formed of monofilaments having a circular cross-section.

Appealed claims 1-5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dugan.

Appellants do not present separate arguments for any particular claim on appeal. Accordingly, all the appealed claims stand or fall together with claim 1.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we are in complete agreement with the examiner that Dugan provides a description of the claimed subject matter within the meaning of Section 102. Accordingly, we will sustain the examiner's rejection for essentially those reasons expressed in the answer.

Appellants do not dispute the examiner's factual determination that Dugan, like appellants, describes and exemplifies a fabric comprising a plurality of uncoated functional monofilaments having a groove-shaped cross-section.

Appellants contend, however, that Dugan does not describe the claimed invention because the fabric of Dugan is not disclosed as being for use in papermaking and papermaking processes, Examples 1-8 of Dugan are comparative examples that are not the patentee's invention, and Dugan does not describe that the comparative examples have reduced air permeability. We agree with the examiner that these arguments are not persuasive.

The claimed recitation of intended use, "for use in papermaking and papermaking related processes," does not serve to structurally distinguish the claimed fabric from the comparative fabrics of Dugan. As pointed out by the examiner, the present specification fails to describe any physical characteristics of fabrics within the scope of the appealed claims that are not possessed by the comparative fabrics of Dugan. Significantly, appellants have not established on this record that the comparative fabrics described by Dugan cannot be used in the broadly claimed class of "papermaking related processes."

Appellants' argument that Dugan is directed to using fibers having a hydrophilic surface modification, or coating, is also without merit. It is not necessary for a finding of anticipation under Section 102 that the description of the claimed invention

in a patent reference be part of the disclosed invention. It is sufficient that the claimed invention is described in any respect, including embodiments of the prior art that are not preferred.

As for the claim recitation regarding reduced air permeability, it is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed by the prior art, the burden is on the applicant to prove that the prior art product does not necessarily or inherently possess characteristics attributed to the claimed product. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In the present case, since the comparative fabrics of Dugan admittedly are made from a plurality of uncoated monofilaments having a grooved-shaped cross-section, it is reasonable to conclude that the fabric has reduced air permeability compared with the fabric formed of monofilaments having a circular cross-section. Hence, it is clear that we do not subscribe to appellants' argument that "there is nothing in Dugan to even suggest that the fabric comprised of grooved fibers would have reduced air permeability as compared to a fabric

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formed of fibers having a circular cross-section" (page 9 of reply brief, second paragraph). We find clear suggestion from Dugan's comparative fabrics being made, like appellants', from synthetic, uncoated monofilaments having a grooved-shaped cross-section. Appellants have advanced no rationale why the comparative fabrics of Dugan would *not* have the claimed reduced air permeability.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

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| EDWARD C. KIMLIN |) | |
| Administrative Patent Judge |) | |
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| BRADLEY R. GARRIS |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
| |) | INTERFERENCES |
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| |) | |
| BEVERLY A. FRANKLIN |) | |
| Administrative Patent Judge |) | |

ECK:hh

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FROMMER LAWRENCE & HAUG
745 FIFTH AVE.
10TH FLOOR
NEW YORK, NY 10151